



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,998	12/07/2000	Hilary A. Coller	2825.2006-001	3011

7590

02/19/2002

Doreen M. Hogle, Esq.
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
Two Militia Drive
Lexington, MA 02421-4799

EXAMINER

ANGELL, JON E

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 02/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/732,998	COLLER ET AL.	
	Examiner	Art Unit	
	J. Eric Angell	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-35 are pending in the application.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, 12 and 34, drawn to a method for inducing expression, classified in class 435, subclass 68.1.
 - II. Claims 6-11 and 35, drawn to a method for repressing expression, classified in class 435, subclass 69.7.
 - III. Claims 13-20, drawn to a screening method to identify agents that regulate myc-dependent transcriptional regulation, classified in class 435, subclass 4.
 - IV. Claims 21-24, drawn to a treatment, classified in class 514, subclass 2 and 4.
 - V. Claims 25-27, drawn to a method for detecting disorders, classified in class 436, subclass 2.
 - VI. Claims 28 and 29, drawn to a method for evaluating drug candidates, classified in class 424, subclass 9.2.
 - VII. Claims 30-33, drawn to a method for detecting myc target genes, classified in class 424, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions I-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

Art Unit: 1635

functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because they are distinct methods with different method steps using different reagents and having different desired results. For instance, Group I involves inducing expression while Group II involves repressing expression—two different effects. Group III is a screening method wherein the desired function is to identify regulatory agents. Group IV is a method of treating a disease/disorder wherein the desired effect is amelioration of disease/disorder. The function of Group V is to detect disorders. Group VI is a method for evaluating the efficacy of drug candidates. Group VII is a method for detecting myc target genes wherein the desired function is to identify genes that are regulated by myc.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. Because these inventions are distinct for the reasons given above and the search required for each Group is not coextensive with the search required for the other Groups, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of genes in the claimed invention:

Species I – AHCY

Species II - CCND2

Species III - ASS

Species IV - FKBP52

Art Unit: 1635

Species V - PBEF

Species VI - TRAP1

Species VII – FABP52

Species VIII - G0S2

Species IX – PPIF

Species X - hsRPB8

Species XI – fibrillin

Species XII – TFRC

Species XIII - CksHs2

Species XIV - SLC16A1

Species XV - IARS

Species XVI - HLA-DRB1

Species XVII - GRPE-homolog

Species XVIII – GPI

Species XIX - HSPD1

Species XX – HDGF

Species XXI - SF2

Species XXII - coup transcription factor

Species XXIII - RPS11

Species XXIV - EIF5A

Species XXV - EIF4-gamma

Species XXVI - A2M

Art Unit: 1635

Species XXVII - TPM1

Species XXVIII - PDGFRA

Species XXIX - FN1

Species XXX - CTGF

Species XXXI - COL3A1

Species XXXII - CDKN1A

Species XXXIII - a dithiolethione-inducible gene.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Inventions I, II, III and V are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 1635

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. A telephone call was made to Lisa Treanie on February 1, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 1635

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Eric Angell whose telephone number is (703) 605-1165. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

J. Eric Angell
February 13, 2002



JEFFREY FREDMAN
PRIMARY EXAMINER